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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,717	02/12/2004	Christopher James Dawson	AUS920030842US1	5923

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EXAMINER	
ALLEN, WILLIAM J	

ART UNIT	PAPER NUMBER
3625	

MAIL DATE	DELIVERY MODE
09/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/777,717	DAWSON ET AL.	
	Examiner	Art Unit	
	William J. Allen	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 July 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-12,14-24,26-34 and 36-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3-12, 14-24, 26-34, and 36-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Prosecution History Summary

Claims 1, 3-12, 14-24, 26-34, and 36-41 are pending and rejected as set forth below.

Response to Arguments

Applicant's arguments with respect to claim7/27/2007 have been considered but are moot in view of the new ground(s) of rejection. Applicant's amendment has necessitated the new grounds of rejection.

Additionally, regarding the rejection of claims 26-36 under 35 USC 101, the Examiner notes that the claims are directed to a shopping token made by a computer implemented process (i.e. a product by process) and thereby directed to the product (the shopping token itself) because product by process claims are limited to the structure implied by the steps of the claim and not the steps themselves [See MPEP 2113]. Despite the fact that the token may be created by computer implemented steps stored in a computer readable medium, the token itself does not constitute statutory subject matter as it amounts to nothing more than a data structure/data per se stored on some medium but lacking any imparted functionality.

Claim Rejections - 35 USC § 101

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 26-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally

interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

Independent claim 26 fails to show imparted functionality and is merely drawn to a data structure (i.e. a *shopping token* containing information). As defined by Microsoft Press Computer Dictionary, Third edition, a token is "a unique structured data element that circulates continuously among nodes of a token ring". Alternatively, a token may be considered "any non-reducible textual element in data that is being parsed". In either case, claim 26 is directed to a data structure/data per se stored on some medium but lacking any imparted functionality, which is considered non-statutory subject matter. Additionally, it is noted that the claims are directed to a shopping token made by a computer implemented process (i.e. a product by process) and thereby directed to the product (shopping token itself) because product by process claims are limited to the structure implied by the steps of the claim and not the steps themselves.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 3-9, 14-21, 26-33, and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albazz et al. (US 20020042872) in view of Conant et al. (US 20020129056) in further view of Conklin et al. (US 6141653).

Regarding claim 1, Albazz teaches a system and method for automating contract negotiations and facilitating contractual activities pursuant to the agreed upon contract (see at least: abstract). Albazz further teaches creating a contract between a buyer and a seller in an online transaction by means of a shopping token that contains a plurality of agreement terms (see at least: abstract, 0016, 0085-0086). More specifically, Albazz creates a contract profile (analogous to the *created file*) with the resulting agreed upon contract "locked" using digital signatures (see at least: 0025 [note the final 2 lines], 0097). Once approved by the negotiating parties and signed utilizing digital signature technology, the contract elements are linked, sealed, and saved (i.e. *responsive to the addition of digital signatures, saving the file as the shopping token*) at the seller's e-commerce site or marketplace (see at least: 0088, 0097). [Note: The saved and locked contract that is executable constitutes a *shopping token*]. Albazz also teaches *wherein data in the shopping token cannot be cut and pasted from the shopping token* by locking the contract to prevent accidental or deliberate changes to the contract elements (i.e. *cut and pasting*

[note applicant's specification, Paragraph 14]) (see at least: 0016, 0086). The contract *can be stored on a buyer computer, a seller computer, or a third party computer* (see at least: 0088), registered as a signed contract (see at least: 0097), and referenced whenever a buyer-seller transaction is initiated. [The Examiner notes that because there are multiple contracts (see at least: 0011, 0106), and because the contracts are stored, registered, and referenced for use in buyer-seller transactions, the different contracts are thereby *indexed so that they can be distinguished* from one another].

Though Albazz teaches where static elements of the contract are locked and the contract itself is stored (see at least: 0088), Albazz does not specifically teach *saving the file as a read only token.*

In the same field of endeavor, Conant teaches a method and apparatus for negotiating the content of a documents via an electronic exchange (see at least: abstract). More specifically, Conant teaches where, upon execution of a contract by both parties using an electronic signature, generating a read-only version of the contract upon which a watermark can be placed on the read-only file (see at least: 0032). Thereby, Conant teaches, in response to applying a digital signature, *saving the file as a read only token.* It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Albazz to have included *saving the file as a read only token* as taught by Conant in order to provide a negotiating tool providing improved document control while facilitating proper interpretation of the document upon completion (see at least: Conant, 0007).

Additionally, Albazz teaches all of the above but does not expressly teach the creation and use of files in *XML*, though Albazz does show compliance with XML and the creation of a contract profile (i.e. *file*) for an associated contract that is modifiable until approved and finalized (see at least: 0046, 0016, 0086).

Also, in the field of electronic negotiations, Conklin teaches a multivariate negotiation engine for iterative bargaining (see at least: abstract). Conklin provides a system operated at the provider's Internet site, the system maintaining internal databases that contain the history of all transaction, and allows buyers and sellers to return to the system to resume negotiations (see at least: abstract, col. 13 lines 61-63, col. 19 lines 29-38, col. 21 lines 39-45, col. 24 lines 1-41). Conklin further teaches where information transmitted through the multivariate negotiation system may be in a variety of formats including HTML, Java, Java Scripting, or XML (see at least: col. 20 lines 45-49, col. 21 lines 32-36, col. 28 lines 23-29).

It would have been obvious to one of ordinary skill in the art at the time of invention to have included the creation and use of files in *XML* as taught by Conklin in order to provide a negotiation engine for iterative bargaining that brings together participants with similar interests and further enables the creation of knowledgeable communities of commerce (see at least: Conklin, abstract (lines 1-4), col. 13 lines 58-60). Additionally, the Examiner points out that Applicant has failed to show the criticality of using XML as opposed to other file formats and further notes that the incorporation of such a feature is no more than the predictable use of prior art elements according to their established function.

Regarding claims 3-7, Albazz in view of Conant in view of Conklin further teaches:

(3) *adding a seller's personal information, a buyer's personal information, information regarding the good, and a plurality of terms to the file* (see at least: Albazz, 0043-0044); The Examiner notes that main information elements in the business contract include a seller profile (*seller personal information*), a buyer profile (*buyer personal information*), traded goods and prices (*information regarding a good*), and terms and conditions.

(4) *presenting the terms to the buyer* and *determining whether the buyer and seller agree with the terms* (see at least: Albazz, abstract (note lines 10-12), 0015, Fig. 7 (note "Post Contract Draft"));

responsive to the determination that the buyer and seller agree with the terms, means for adding a buyer digital signature and a seller digital signature to the file to create a shopping token (see at least: Albazz, 0025, 0043, 0097). The Examiner notes that the contract must be approved by both parties (see at least: Fig. 7).

(5) *responsive to the determination that the buyer and seller do not agree with the terms, means for accepting a modification to the terms* (see at least: Albazz, abstract, 0039, Fig. 7 and 9).

(6) *wherein the shopping token is created after the buyer is aware of the delivery date* (see at least: Albazz, 0043). The Examiner notes that the main elements further include delivery mechanisms and schedules (i.e. *deliver date*). Furthermore, these terms are agreed upon (and thereby the buyer is aware of the delivery schedule) before the contract is saved and stored (i.e. *the shopping token is created*).

(7) *wherein the shopping token may be configured so that the shopping token is not modifiable by the buyer or seller* (see at least: 0016, 0025, 0097).

Regarding claims 8-9, though Albazz teaches storing the contract as an enforceable contract with the seller (see at least: 0088), Albazz does not expressly teach *wherein the shopping token is stored on a third party computer and is accessible by the buyer and the seller* nor does Albazz teach where the terms included in the token contains *warranty information.* Conklin teaches a negotiations system operated at a system provider's (third party) site at which buyers and sellers gather to perform electronic negotiations. Both changes to the negotiated terms and accepted/finalized terms are stored in the system. Thereby, Conklin teaches *wherein the shopping token is stored on a third party computer and is accessible by the buyer and the seller* (see at least: abstract, col. 24 lines 1-41, col. 25 lines 12-20). Conklin also teaches negotiating terms including warranty information for a good (see at least: Fig. 28, col. 1 lines 41-47, col. 30 line 66-col. 31 line 11). It would have been obvious to one of ordinary skill in the art at the time of invention to have included *wherein the shopping token is stored on a third party computer and is accessible by the buyer and the seller* and to have included terms regarding *warranty information* as taught by Conklin in order to provide a negotiation engine for iterative bargaining that brings together participants with similar interests and further enables the creation of knowledgeable communities of commerce (see at least: Conklin, abstract (lines 1-4), col. 13 lines 58-60).

Regarding claims 14-21 and 26-33, claims 14-21 and 26-33 closely parallel claims 1and 3-9 and are thereby rejected for at least the reasons above with regards to claims 1 and 3-9.

Regarding claims 37-38, claims 37-38 parallel the limitations from claims 1and 3-9 and is thereby rejected for at least the reasons above with regards to claims 1 and 3-9.

3. Claims 10-12, 22-24, 34-36, and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albazz in view of Conant in view of Conklin as applied to claims 1, 3-9, 14-21, 26-33, and 37-38, and in further view of Moss et al. (US 20050160014).

Regarding claims 10-12, 22-24, 34, 36, and 39-41, Albazz in view of Conant in view of Conklin teaches all of the above as noted but does not expressly teach *wherein the shopping token is used for price protection and price promotion for the good, and to analyze a seller's history by a buyer.* Moss teaches *wherein the shopping token is used for price protection and price promotion for the good* (see at least: 0007, 0032, 0047, Fig. 30-31). Note the price matching includes the retailer's own advertised prices (Fig. 31). Additionally, Moss teaches a *buyer analyzing the history of a seller* by providing a buyer with the ability to view transactions within the last 3 months or since joining the service ("historical price match transactions") to determined the outcome and savings received from each transaction (see at least: 0082, Fig. 4). The Examiner notes that each transaction shows an associated seller and the amount saved by using that seller, thereby providing a *seller history* for the buyer. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Albazz in view of Conant in view of Conklin to have included *wherein the shopping token is used for price protection and price promotion for the good* as taught by Moss in order to provide a service that helps users find and compare the best prices and promotions available (see at least: Moss, 0006).

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William J. Allen
Patent Examiner
August 31, 2007

Mark Fadok

Primary Examiner